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| EXAMINER |
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HUSON, MONICA ANNE

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| ART UNIT | PAPER NUMBER |
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1732

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,079

Applicant(s)

ROSENBERG ET AL.

Examiner

Monica A. Huson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the paper filed 17 July 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7-9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Dabal et al. (U.S. Patent 4,072,551). Regarding Claim 1, Dabal et al., hereafter "Dabal," show that it is known to carry out a method for producing tablets by melt extrusion (Column 8, lines 1-44; Column 10, lines 3-13), in which an extrudable pharmaceutical mixture is heated and extruded in the form of a continuous product strip, wherein, in a first stage, the still deformable product strip is compressed to a continuous tablet belt, the individual tablets in the belt being connected together by product webs (Figure 5, element 82, 83), in a second stage, downstream of the first stage, the tablet belt is allowed to cool to form a solidified tablet belt (Figure 5, printing unit; It is noted that ambient cooling will take place along the transport sections.), in a third stage, downstream of the second stage, the tablets are mechanically singulated in a continuous process (Figure 5, unitizing unit), and then the singulated tablets are transported further to a fourth stage downstream of the said third stage where the singulated tablets are subsequently deflashed (Column 32, lines 13-18).

Regarding Claim 2, Dabal shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein a force with a

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component perpendicular to the plane of the tablet belt is allowed to act on the tablet belt for singulation of the tablet (Figure 5, unitizing unit; It is noted that the force exerted by the roller will have at least two components.).

Regarding Claim 3, Dabal shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein a force with a component parallel to the plane of the tablet belt is allowed to act on the tablet belt for singulation of the tablets (Figure 5, unitizing unit; It is noted that the force exerted by the roller will have at least two components.).

Regarding Claim 5, Dabal shows the process as claimed as discussed in the rejection of Claim 3 above, including a method wherein the parallel force component is generated by exerting a traction force on the solidified tablet belt (Figure 5, unitizing unit; It is noted that the force exerted by the rollers will include some traction force.).

Regarding Claim 12, Dabal shows that it is known to have an apparatus for producing tablets (Figure 5), comprising at least one extruder means for heating a pharmaceutical mixture (Column 8, lines 1-44; Column 10, lines 3-13); means for shaping a tablet belt from said extruded heated pharmaceutical mixture arranged downstream of said extruder (Figure 5, element 82, 83); first transport means for said tablet belt comprising means for cooling the extruded tablet belts and which is arranged downstream of said shaping means (Figure 5, printing unit; It is noted that ambient cooling will take place along the transport sections.), and means for singulating and deflashing said tablets, wherein said means for singulating and deflashing said tablets comprise at least one singulating means arranged downstream of said first transport means and at least one deflashing means arranged downstream of said singulating means and spatially separate therefrom (Figure 5, unitizing unit; Column 32, lines 13-18; It is noted that the transport means is the tension force that is generated by the two rollers acting together on the tablet belt.).

Regarding Claim 7, Dabal shows the apparatus as claimed as discussed in the rejection of Claim 12 above, including a machine wherein the singulating means comprises at least one rotatable roller (Figure 5, unitizing unit).

Regarding Claim 8, Dabal shows the apparatus as claimed as discussed in the rejection of Claim 7 above, including a machine wherein the singulating means comprises two counter-rotating rollers which can be pressed against one another (Figure 5, unitizing unit).

Regarding Claim 9, Dabal shows the apparatus as claimed as discussed in the rejection of Claim 12 above, including a machine wherein the singulating means comprises at least one embossed roller (Column 22, lines 58-63).

Regarding Claim 11, Dabal shows the apparatus as claimed as discussed in the rejection of Claim 12 above, including a machine wherein a second transport means is provided between the singulating means and the deflashing means and the deflashing means comprises a shaking or vibrating unit (Column 30, lines 12-19; Column 32, lines 13-18; It is noted that by suggesting that the tablets are amenable to online testing throughout their production, Dabal implies that the tablets are transported from the unitizing to the deflashing operation in a predetermined fashion.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dabal, in view of Klimesch et al. (U.S. Patent 5,073,379). Dabal shows the process as claimed as discussed in the rejection of Claims 1 and 2 above, but

he does not show a directional force that diverts the tablet belt in a specific direction. Klimesch '379 shows that it is known to carry out a method wherein the perpendicular force component is generated by diverting the solidified tablet belt out of its transport plane (Figure 1; Column 2, lines 61-67). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Klimesch '379's diverting force to tabulate Dabal's belt in order to most efficiently achieve the unitizing operation.

Response to Arguments

Applicant's arguments filed 17 July 2006 have been fully considered but they are not persuasive.

Applicant contends that Dabal does not show the instant invention because he does not show extruding a pharmaceutical mixture in the form of a continuous product strip. Applicant appears to imply that a pharmaceutical mixture necessarily requires an active ingredient. This is not persuasive because the claim does not exclusively require extruding a mixture containing an active ingredient, and it is maintained that Dabal's extruded mixture does contain pharmaceutical ingredients (Column 8, lines 35-50). Although Dabal's active ingredient is not extruded with the product web, it is maintained that he nevertheless extrudes a pharmaceutical mixture.

Applicant contends that Dabal does not show the instant invention because he does not show, in a first stage, compressing the still deformable product strip to a continuous tablet belt. This is not persuasive because Dabal shows this limitation in Figure 5, elements 82, 83, and 85.

Applicant contends that Dabal does not show the instant invention because he does not show allowing the tablet belt to cool to form a solidified tablet belt. Applicant disagrees with the examiner that transport of the belt among the processing stations will allow for ambient cooling. The examiner maintains her rejections and points to US 4,692,199 *to support the assertion*

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that ambient cooling occurs during passage of an article through ambient conditions (Abstract) (e.g. from a processing station to a final station).

Applicant contends that Dabal does not show the instant invention because he does not show a force with a component perpendicular to the plane of the tablet belt for singulation of the tablets. This is not persuasive because Dabal shows this limitation as his Rotary Unitizing element. With respect to claim 7, the phrase "for diverting the tablet belt out of a transport plane" has been interpreted as only an intended use or consequence of the positively-recited method claims.

Applicant has not specifically argued the rejections made under 35 USC 103.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

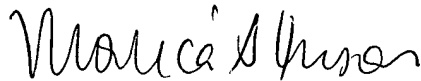
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monica A Huson

October 2, 2006


CHRISTINA JOHNSON
PRIMARY EXAMINER
10/4/06